

### **REMARKS**

By the present amendment, claim 1 has been amended to incorporate the subject matter of claim 10 and to replace “swelling reaches a saturation state” by “swelling of the polymer film occurs abruptly” and “the swelling reaches the saturation state” by “the swelling of the polymer film has occurred abruptly.”

Also, new claim 31 has been added.

Support for the added recitations is found in the original application, for example, on page 3, line 3 to page 4, line 1 and page 12, line 37, page 14, line 14, and 30.

Claims 1, 8-9, 11-18, and 31 are pending in the present application.

#### **I. Indefiniteness rejection**

In the Office Action, claim 12 is rejected under 35 U.S.C. 112, second paragraph, as indefinite. It is alleged that the term “the guide roll” lacks antecedent basis in claim 1.

By the amendment of August 4, 2008, claim 12 has been amended to replace “wherein the guide roll is at least one selected from...” by “wherein at least one of the first and second guide rolls is selected from....” Accordingly, it is submitted that the rejection should be withdrawn.

#### **II. Art rejections**

In the Office Action, the following rejections are made:

- Claims 1, 8, 10, and 14-17 are rejected under 35 U.S.C. 103(a) as obvious over Ikemoto et al., JP10-153709A (“Ikemoto”),

- Claim 9 is rejected under 35 U.S.C. 103(a) as obvious over Ikemoto in view of Sanefuji et al., US2002/0001700A1 (“Sanefuji”),
- Claim 11 is rejected under 35 U.S.C. 103(a) as obvious over Ikemoto in view of Harita et al., US2001/0024322A1 (“Harita”),
- Claim 12 is rejected under 35 U.S.C. 103(a) as obvious over Ikemoto in view of Burger, US3,492,185 (“Burger”),
- Claim 13 is rejected under 35 U.S.C. 103(a) as obvious over Ikemoto in view of Kondo, JP2000-147252 (“Kondo”), and
- Claim 18 is rejected under 35 U.S.C. 103(a) as obvious over Ikemoto et al. in view of US5,071,906 to Tanaka et al. (“Tanaka”).

Reconsideration and withdrawal of the rejections is respectfully requested. It is submitted that Ikemoto describes the length of time for impregnation in a swelling bath as a whole, but Ikemoto is completely silent regarding the presence or absence of guide rolls, and the length of time required for a PVA resin film to be brought into contact with the first guide roll. Further, Ikemoto also fails to provide any teaching or guidance regarding the timing of swelling of a PVA resin film is impregnated in an aqueous solvent in a swelling bath, let alone a time range in which the swelling of the PVA resin film occurs abruptly.

Furthermore, Ikemoto discloses that “the swelling of the PVA resin film is not controlled, and thus the PVA resin film tends to be swollen excessively” (Ikemoto at paragraph [0007]). In addition, in Ikemoto, the comparative and working examples employ swelling times of 4, 5, and

6 minutes, respectively. If the film is swollen to a maximum extent within 25 seconds, there can never be excessive swelling. However, in Ikemoto, swelling is allowed to occur for a length of time as long as 4 minutes or more. This proves that, in Ikemoto, a length of time required to allow the film to be swollen to the maximum extent is about several minutes.

In contrast, the present inventors have determined that when a hydrophilic polymer film is impregnated in an aqueous solvent in a swelling bath, generally, swelling occurs abruptly within 15 to 25 seconds, as disclosed on page 3, line 3 to page 4, line 1 of the present specification. If the polymer is impregnated in this swelling bath for a longer time of not less than 100 seconds, swelling reaches or almost reaches a saturation state, as disclosed on page 13, line 25 to 33 of the present specification.

In fact, a hydrophilic polymer film surely has high hydrophobicity, but it is unlikely that the polymer film reaches the state of being swollen to the maximum extent (swelling reaches a saturation state) within a length of time as short as 25 seconds.

Thus, in the presently claimed invention:

- the polymer film is brought into contact with the first guide roll before swelling of the polymer film occurs abruptly, and
- the polymer film is brought into contact with the second guide roll after the swelling of the polymer film has occurred abruptly.

An advantage of the presently claimed invention is that it is possible to prevent wrinkles from being formed on the surface of a guide roll in a swelling bath, as explained at page 3, line 3

Amendment Under 37 C.F.R. 1.114  
U.S. Appl No. 10/522,618  
Attorney Docket No. 052009

to page 4, line 1 of the present specification. This feature of the presently claimed invention and its advantages are not taught or suggested in Ikemoto, and the other cited references fail to remedy this deficiency. Therefore, the present claims are not obvious over Ikemoto taken alone or in any combination with the other cited references.

In view of the above, it is submitted that the rejections should be withdrawn.

Conclusion

In conclusion, the invention as presently claimed is patentable. It is believed that the claims are in allowable condition and a notice to that effect is earnestly requested.

If there is, in the Examiner's opinion, any outstanding issue and such issue may be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

If this paper is not timely filed, Applicant(s) respectfully petition(s) for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,  
**WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP**



Nicolas E. Seckel  
Attorney for Applicants  
Registration No. 44,373  
Telephone: (202) 822-1100  
Facsimile: (202) 822-1111

NES/rep